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CONLEY ROSE, P.C. 600 TRAVIS SUITE 7100 HOUSTON, TX 77002				
EXAMINER				
BASTIANELLI, JOHN				
ART UNIT		PAPER NUMBER		
3753				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/564,586

**Applicant(s)**

BIESTER, KLAUS

**Examiner**

John Bastianelli

**Art Unit**

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-13, 16, 18, 20, 23, 25-27, 29, 30, 32, 33, 36 and 37 is/are pending in the application.  
4a) Of the above claim(s) 4-9, 11-13, 20, 26, 29, 30, 36 and 37 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 16, 18, 23, 25, 27, 32 and 33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/18/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-5,16,18, 23,25,27, 29-30, 32 and 33 in the reply filed on May 26, 2009 is acknowledged. The examiner believes this is substantially correct although claims 4-5, 29 and 30 do not read on Figures 1-3 thus are restricted out and not examined. Also, the examiner does not see support for claim 16 in Figs. 1-3. Thus claims 1-3,16,18, 23, 25, 27, 32 and 33 are examined below.
2. Claims 4-9, 11-13, 20, 26, 29-30, 36 and 37 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 26, 2009.

### ***Claim Objections***

3. Claims 1-3,16,18, 23, 25, 27, 32 and 33 are objected to because of the following informalities: The claims are replete with errors. For example in claim 3, the term "axially immovably" should be axially immovable" and this type of grammatical error is seen throughout the claims. In claim 16, the term "the device housing" is not in claim 2 (it appears first in claim 3). Also, what are the metes and bounds of the term "essentially" which is used extensively in the claims? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3753

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3,16,18, 23, 25, 27, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner cannot understand how the claims read on applicant's disclosure as they are so indefinite (see rejections below).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3,16,18, 23, 25, 27, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 1, the phrase "or similar" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or similar"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

9. Regarding claim 1, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

10. Regarding claim 2, it is indefinite as "a recirculating roller or ball spindle drive". Does this mean it could be roller or ball type spindle drive or does it mean recirculating roller or ball spindle type drive?
11. Regarding claim 16, two or more drive shafts each with at least one motor", is this supposed to include the motor of claim 1 or are these other separate motors?

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 18, 23, 32 and 33, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al. GB 896,896.
- Lang discloses a drive device (Fig. 1) for the adjustment of an actuating element (connected to 2) of a device having at least one spindle drive (2, 3, 4) movably connected to the actuating element and a gear unit arranged between the spindle drive and at least one motor; the gear unit exhibiting a reduction gear assigned to the spindle drive, and a spur gear assigned to the motor. The spindle drive is seen as a recirculating roller or ball spindle drive with a spindle nut 3, 4 and threaded spindle 2. The spindle nut is supported rotationally, but axially immovable in a device housing (Fig. 1). The motor is an electric motor. At least one engaging element protrudes radially outwards from the threaded spindle or spindle nut and engages slots of a fixed sleeve

and a rotating sleeve whereby a first slot extends essentially in the axial direction and a second slot at an acute angle to the first slot.

14. Claims 1-3, 18, 23, 32 and 33, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Howard US 863,180.

Howard discloses a drive device (Fig. 1) for the adjustment of an actuating element 24 of a device having at least one spindle drive 34 movably connected to the actuating element and a gear unit 45, 46 arranged between the spindle drive and at least one motor 49; the gear unit exhibiting a reduction gear 45, 46 assigned to the spindle drive, and a spur gear 47 assigned to the motor. The spindle drive is seen as a recirculating roller or ball spindle drive with a spindle nut 34 and threaded spindle 25. The spindle nut is supported rotationally, but axially immovable in a device housing (Fig. 1). The motor is an electric motor. At least one engaging element protrudes radially outwards from the threaded spindle or spindle nut and engages slots of a fixed sleeve and a rotating sleeve whereby a first slot extends essentially in the axial direction and a second slot at an acute angle to the first slot.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al. GB 896,896.

Lang lacks multiple motors on multiple drive shafts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make single motor with a single shaft into multiple combinations since this is mere duplication of the essential working parts of a device involves only routine skill in the art, as this would provide more power and a backup if one were to fail. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (CA 7 1977).

17. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howard US 863,180.

Lang lacks multiple motors on multiple drive shafts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make single motor with a single shaft into multiple combinations since this is mere duplication of the essential working parts of a device involves only routine skill in the art, as this would provide more power and a backup if one were to fail. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (CA 7 1977).

18. Claims 25 and 27, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al. GB 896,896 in view of McGregor et al. US 5,983,743.

Lang lacks position sensor having a flat code carrier. McGregor discloses a position sensor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a position sensor of McGregor on the axially movable part of Lang in order to turn the motor off to conserve power. It would have been obvious to

one having ordinary skill in the art at the time the invention was made to use a position sensor of McGregor offset radially outwards of the threaded spindle Lang having a flat code carrier as this would make reading the position of the threaded spindle easy.

19. Claims 25 and 27, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard US 863,180 in view of McGregor et al. US 5,983,743.

Howard lacks position sensor having a flat code carrier. McGregor discloses a position sensor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a position sensor of McGregor on the axially movable part of Howard in order to turn the motor off to conserve power. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a position sensor of McGregor offset radially outwards of the threaded spindle Howard having a flat code carrier as this would make reading the position of the threaded spindle easy.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as it discloses gears with spindles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Bastianelli whose telephone number is (571) 272-4921. The examiner can normally be reached on M-Th (8-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on (571) 272-4777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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